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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,259	03/28/2001	Susumu Yoshida	2500.65361	1995

7590

12/26/2002

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EXAMINER

FALASCO, LOUIS V

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 12/26/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-3

Office Action Summary

Application No.

09/820,259

Applicant(s)

YOSHIDA ET AL.

Examiner

Louis Falasco

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

A. Claims

1. Claims 1 - 14 have been presented for examination.
 - Claims 1 - 14 are subjected to restriction under 35 U.S.C. 121.

B. Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1 - 3, drawn to abrading apparatus, classified in class 451
ABRADING, subclass 64.

Group II. Claims 4 - 6, drawn to texturing processes, classified in class 451
ABRADING, subclass 28.

Group III. Claim 7 - 14, drawn to disk shaped substrates, classified in class
428 STOCK MATERIAL OR MISCELLANEOUS ARTICLES, subclass 64.1.

2. The inventions are distinct, each from the other because of the following reasons:
 - Inventions **Group II** and **Group I** are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case apparatus as claimed can be used to practice another and

materially different process such as the use of the rotational spindle to add material and coat the substrate.

- Inventions **Group II** and **Group III** are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case that the product as claimed can be made by another and materially different process such as molding by heat to a fluid state and reshape the edge of the disk in a mold.
- Inventions **Group I** and **Group III** are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case that the product as claimed can be made by another and materially different apparatus such as molding means having means to heat to a fluid state and reshape, forming the edge of the disk shaped article.

Art Unit: 1773

3. A telephone call was made to *Patrick Burns, esq.* on December 4, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Contacts:


- Any inquiry concerning this communication from the examiner should be directed to examiner Louis Falasco, Ph.D. whose telephone number is 703.305-6974. The examiner can normally be reached M-F 9:30 AM - 6:00 PM.
- If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Paul Thibodeau may be reached at 703.308-2367.
- The Fax phone numbers for the organization where this application or proceeding is assigned are: 703.872-9310 for regular communications and 703.872-9311 for after 'Final' communications.
- An inquiry of a general nature or relating to status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308-0651.

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Art Unit 1773

December 5, 2002



STEVAN A. RESAN
PRIMARY EXAMINER